e.g. expression vectors, the necessary common attribute is the ORF (SEQ ID NO: 2).

Weighing all factors including (1) that the full length ORF (SEQ ID NO: 2) is disclosed and (2) that any substantial variability within the genus arises due to addition of elements that are not part of the inventor's particular contribution, taken in view of the level of knowledge and skill in the art, one skilled in the art would recognize from the disclosure that the applicant was in possession of the genus of DNAs that comprise SEQ ID NO: 2.

Conclusion: The written description requirement is satisfied.

Example 9: <u>Hybridization</u>

Specification: The specification discloses a single cDNA (SEQ ID NO:1) which encodes a protein that binds to a dopamine receptor and stimulates adenylate cyclase activity. The specification includes an example wherein the complement of SEQ ID NO: 1 was used under highly stringent hybridization conditions (6XSSC and 65 degrees Celsius) for the isolation of nucleic acids that encode proteins that bind to dopamine receptor and stimulate adenylate cyclase activity. The hybridizing nucleic acids were not sequenced. They were expressed and several were shown to encode proteins that bind to a dopamine receptor and stimulate adenylate cyclase activity. These sequences may or may not be the same as SEQ ID NO: 1.

Claim:

An isolated nucleic acid that specifically hybridizes under highly stringent conditions to the complement of the sequence set forth in SEQ ID NO: 1,

wherein said nucleic acid encodes a protein that binds to a dopamine receptor and stimulates adenylate cyclase activity.

Analysis:

A review of the full content of the specification indicates that the essential feature of the claimed invention is the isolated nucleic acid that hybridizes to SEQ ID NO: 1 under highly stringent conditions and encodes a protein with a specific function. The art indicates that hybridization techniques using a known DNA as a probe under highly stringent conditions were conventional in the art at the time of filing.

The claim is drawn to a genus of nucleic acids all of which must hybridize with SEQ ID NO: 1 and must encode a protein with a specific activity.

The search of the prior art indicates that SEQ ID NO: 1 is novel and unobvious.

There is a single species disclosed (a molecule consisting of SEQ ID NO: 1) that is within the scope of the claimed genus.

There is actual reduction to practice of the disclosed species.

Now turning to the genus analysis, a person of skill in the art would not expect substantial variation among species encompassed within the scope of the claims because the highly stringent hybridization conditions set forth in the claim yield structurally similar DNAs. Thus, a representative number of species is disclosed, since highly stringent hybridization conditions in combination with the coding function of DNA and the level of

skill and knowledge in the art are adequate to determine that applicant was in possession of the claimed invention.

Conclusion: The claimed invention is adequately described.

Example 10: <u>Process claim</u>

Specification: The specification teaches that SEQ ID NO: 10 is an EST. The specification also teaches that SEQ ID NO: 10 is a chromosome marker and that any DNA which hybridizes under specified stringent conditions to SEQ ID NO: 10 will be useful as a marker for detecting the presence of Burkitt's lymphoma. The specification also teaches how to produce DNAs including genomic DNAs which hybridize to SEQ ID NO: 10 and isolation of said DNAs. The specification presents an example where a genomic DNA is probed with SEQ ID NO: 10 under the specified stringent conditions (6XSSC and 65 degrees Celsius) and the genomic DNA which hybridizes under these conditions is isolated and is sequenced. The sequence of this genomic clone is represented by SEQ ID NO: 11.

Claim:

Claim 1: A process for producing an isolated polynucleotide comprising hybridizing SEQ ID NO: 10 to genomic DNA in 6XSSC and 65° C and isolating the DNA polynucleotide detected with SEQ ID NO: 10.

Claim 2: An isolated DNA that hybridizes with SEQ ID NO: 10.

Analysis:

Claim 1:

A review of the full content of the specification indicates that the essential feature of the claimed invention is a process of obtaining a nucleic acid sequence which is identified by a probe that hybridizes to SEQ ID NO:10 and a polynucleotide that hybridizes with SEQ ID NO: 10. The

specification and the general state of the art indicate that the general process of producing nucleic acids through hybridization with probes was routine at the time of filing.

The claim is drawn to a genus i.e., a process of hybridizing to genomic DNA with SEQ ID NO: 10 and isolating the DNA which hybridizes under specific conditions to said sequence.

The search indicates that SEQ ID NO: 10 and SEQ ID NO: 11 are novel and unobvious sequences. Therefore, under the examination guidelines of *In re Ochiai* and *In re Brouwer*, the method of making a novel and unobvious product is also novel and unobvious.

The specification presents an example where a single species has been reduced to practice, i.e., isolation of SEQ ID NO: 11 based on hybridization with SEQ ID NO: 10. Therefore the disclosed species within the genus has been adequately described. Now turning to the genus analysis, the art indicates that there is no substantial variation within the genus because of the stringency of hybridization conditions which yields structurally similar molecules. The single disclosed species is representative of the genus because reduction to practice of this species, considered along with the defined hybridization conditions and the level of skill and knowledge in the art, are sufficient to allow the skilled artisan to recognize that applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus.

Claim 2:

The claim is drawn to a genus of nucleic acids, all of which must hybridize to SEQ ID NO: 10. The claim does not specify any stringency conditions. The claim is broad and reads on virtually any nucleic acid.

There is a species disclosed, SEQ ID NO: 11. The art indicates that there is substantial variation within the genus because the lack of stringency of hybridization conditions would be expected to yield structurally unrelated nucleic acid molecules. The single disclosed species is not representative of the genus because there is no structural attribute or feature that is common to the members of the genus.

Conclusion:

Claim 1 is adequately described.

Claim 2 should be rejected as lacking adequate written description following the analysis described above.

Note: Applicant may overcome the written description rejection of the product by, for example, substituting claim 2 with a product by process claim such as the one below.

Claim 2. *The isolated DNA polynucleotide prepared according to the process of claim 1.*